

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Scott Miller

Confirmation No.: 8682

Serial No. : 09/776,936

Examiner: Shailendra Kumar

Filed : December 22, 1998

Group Art Unit: 1621

Title : INHIBITION OF RAF KINASE USING SYMMETRICAL
AND UNSYMMETRICAL SUBSTITUTED DIPHENYL UREAS

REPLY

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SIR:

In response to the Office Action mailed on September 13, 2011, please consider the following remarks.

The rejection of solvates, the only issue, is based on allegations of lack of written description.

Compliance with the written description requirement is essentially a fact-based inquiry that will "necessarily vary depending on the nature of the invention claimed." *Vas-Cath Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1117 (citing *In re DiLeone*, 58 C.C.P.A. 925, 436 F.2d 1404, 1405, 168 USPQ 592, 593 (1971)). The claims of the current application that are currently rejected are directed to compounds of formula I in a solvated form. That the base compounds of formula I are well defined in the specification is not in dispute.

The Office Action alleges that the compounds of formula I being in solvate form is a critical element of the claims. The USPTO Guidelines define critical elements saying, "The claimed invention as a whole may not be adequately described if the claims require an essential